

ATTORNEY DOCKET NO.
034166.033



TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Umicore AG & Co. KG
MARK : MICROBOND and design
SERIAL NO. : 79/030,648
APPLICATION FILED : August 8, 2006
EXAMINING ATTORNEY : Leigh Lowry
LAW OFFICE : 104

TRANSMITTAL LETTER

Box Responses-NO FEE
Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

Madam:

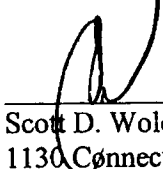
Transmitted herewith is:

ITEMS	FEE
Request for Reconsideration (12 pages)	\$0.00

- ☐ Our check in the amount of \$0.00 is attached hereto.
☒ Please charge our Deposit Account No. 02-4300 for any additional fees that may be required, or credit our account for any overpayment.

Respectfully Submitted,
Smith, Gambrell & Russell, L.L.P.

By:



Scott D. Woldow, Esq.
1130 Connecticut Avenue, N.W., Suite 1130
Washington, D.C. 20036
Tel: (202) 263-4300
Fax: (202) 263-4329

10-29-2008

ATTORNEY DOCKET NO.
034166.033

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT	:	Umicore AG & Co. KG
MARK	:	MICROBOND and design
SERIAL NO.	:	79/030,648
APPLICATION FILED	:	August 8, 2006
EXAMINING ATTORNEY	:	Leigh Lowry
LAW OFFICE	:	104

REQUEST FOR RECONSIDERATION

Box Responses-NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

This filing responds to the Final Office Action mailed May 1, 2008, wherein the Examining Attorney maintained and made final a finding of likelihood of confusion with respect to United States Trademark Registration No. 1379912. The Examiner withdrew the likelihood of confusion refusal with respect to United States Registration No. 785606 and accepted the color claim and color description. In addition, the Examiner continued requirements to amend the identification of goods. As such, Applicant amends the application and responds as follows.

AMENDMENTS

Reconsideration of the Office Action is respectfully requested. The Examiner has raised certain informalities that are addressed in this response.

Identification of Goods

In an effort to further clarify the identification of goods and to distinguish Applicant's goods from the Registrant's goods, Applicant amends the identification of goods as follows:

International Class 1:

Chemicals for soldering of metals as part of electronic components.

International Class 6:

Common metals and their alloys, namely tin alloys, lead alloys, copper and its alloys, German silver alloys and silver solder alloys for use in manufacturing electronic components; brazing alloys, namely, copper and its alloys, German silver alloys, silver solder alloys, nickel alloys, cobalt alloys and germanium alloys for use in manufacturing electronic components; soldering wire of metal for use in manufacturing electronic components; rods of metal for brazing for use in manufacturing electronic components; metals in powder form for use in manufacturing electronic components; common metals, unwrought or semi-wrought, namely, tin, lead, copper, German silver, silver solder, nickel, cobalt and germanium for use in manufacturing electronic components.

International Class 9:

Integrated circuit chips.

International Class 14:

Precious metals and their alloys for use in manufacturing electronic components; goods in precious metals or coated therewith in the form of sealing rings, ribbons, foils, wires, wire rings, disks, squares, frames and washers for use in manufacturing electronic components.

Applicant has revised the identification of goods substantially to identify the specific nature of the goods and to specifically narrow the trade channels to "manufacturing of electronic components." It is respectfully submitted that the further narrowing of the identification of goods differentiates Applicant's mark from the cited mark and eliminates source confusion.

Applicant has specified "German silver alloys" and "silver solder alloys" in International Class 6. "German silver" and "silver solder" are expressly accepted by the United States Acceptable Identification of Goods and Services Manual. Electronic copies of the Identification Manual are attached for the Examiner's consideration. Germanium is considered a "common metal" or a "common metal alloy". Attached please find an electronic webpage from the World Intellectual Property Office International Classification of Goods and Services Manual under the Ninth Edition of the Nice Agreement that shows this identification correctly classified in International Class 6. This language is within the scope of the trademark application as filed.

The identification "precious metals and their alloys" has been accepted by the examining attorney. The remaining portion of the identification of goods in Class 14 merely identifies the physical form of the "precious metals" i.e., in the form of rings, ribbons, foils, wires, wire rings, disks, squares, frames and washers. As such, this portion of the identification of goods is acceptable.

REMARKS

Reconsideration of the Office Action dated May 1, 2008 is respectfully requested.

Likelihood of Confusion

A. The Likelihood Of Confusion Standard

The Examining Attorney may refuse registration of an applicant's mark under section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) only if "confusion is likely because of concurrent use of the marks of an applicant and a prior user on their respective goods." In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360 (C.C.P.A. 1973). Confusion may occur if a purchaser of the goods believe that they come from a common source. In this case, confusion is unlikely.

In determining whether there is a likelihood of confusion between two marks, one must look to the criteria identified by the Court of Customs and Patent Appeals in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360 (C.C.P.A. 1973). In *du Pont*, the court provided a checklist of thirteen different factors that may be used in evaluating a claim of likelihood of confusion. Id. at 1361. The *du Pont* factors that are most relevant to this case are as follows:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" v. careful, sophisticated purchasing.

Id. at 1361.

B. Considered In Their Entireties, The Marks Are Dissimilar In Appearance

Applicant's mark is dissimilar from the cited mark due to the addition of the fanciful color design. The added design element helps to distinguish the marks, especially considering the further limitation of the identification of goods and the restriction of the trade channels. As

the Examining Attorney indicates, the design connotes the "M", which is the first letter of the mark, and is likely to be considered and recognized by the consumer. In this case, the distinguishing nature of the design is important considering the crowded field of marks that use the terms "micro" and "bond".

C. The Goods Of The Applicant And The Registrant Are Dissimilar

Applicant's provides the following goods, "chemicals for soldering of metals as part of electronic components," in Class 1; "Common metals and their alloys, namely tin alloys, lead alloys, copper and its alloys, German silver alloys and silver solder alloys for use in manufacturing electronic components; brazing alloys, namely, copper and its alloys, German silver alloys, silver solder alloys, nickel alloys, cobalt alloys and germanium alloys for use in manufacturing electronic components; soldering wire of metal for use in manufacturing electronic components; rods of metal for brazing for use in manufacturing electronic components; metals in powder form for use in manufacturing electronic components; common metals, unwrought or semi-wrought, namely, tin, lead, copper, German silver, silver solder, nickel, cobalt and germanium for use in manufacturing electronic components," in Class 6; "integrated circuit chips," in Class 9; "Precious metals and their alloys for use in manufacturing electronic components; goods in precious metals or coated therewith in the form of sealing rings, ribbons, foils, wires, wire rings, disks, squares, frames and washers for use in manufacturing electronic components," in Class 14.

The 0785606 Registrant provides, "electrical resistance welders."

Applicant has considerably narrowed the identification of goods to define the precise goods, trade channels and marketing channels. Applicant provides highly specialized chemicals

that are used for the manufacture of electronic components; common metals and alloys for use in the manufacture of electronic components and integrated circuit chips.

Applicant's goods are used in the semiconductor chip bonding field. Applicant's market is highly sophisticated. The purchasers of the goods are trained professionals in a narrow industry. Applicant produces high-purity metals, alloys, compounds and engineered products for advanced applications. Applicant produces a range of complex functional materials based on precious metals and its expertise in technology platforms such as catalysis and surface technology. Applicant is a world market leader in recycling complex waste streams containing precious and other non-ferrous metals. Purchasers of these goods will be able to distinguish the Applicant's products from "electrical resistance welders."

In fact, source confusion is essentially eliminated due to the highly educated nature of the purchasers. Moreover, the revised description of the goods limits the goods to the electronic component manufacturing industry. Applicant is a world leader in the field with a long history of metal and chemical capabilities. The Registrant, on the other hand, provides, "electrical resistance welders." These goods are machines that weld at high temperatures ranging from 400° to 800° Fahrenheit.¹ The process uses a combination of heat and pressure to form a weld.

The Examining Attorney has responded that the goods are related because soldering and welding are related. Third party evidence has been provided to support the Examiner's contention. Applicant has expressly limited the chemical goods, metals, precious metals and alloys to the electronic component manufacturing industry. None of the evidence in the Final Office Action mentions goods related to the manufacture of electronic components. Applicant's goods have been expressly limited to this field.

¹ This is evident from the Registrant's specimen submitted with the renewal filing.

Moreover, the product listed in the trademark registration has a specific function and is limited to a narrow industry. The goods are "electrical resistance welders" in Class 11. These goods are not related to Applicant's goods. Moreover, electrical resistance welding equipment is expensive. Applicant's identification of goods distinguishes the goods, the processes involved, the trade channels and the marketing channels. It is respectfully submitted that Applicant's narrowed identification of goods clearly distinguishes the Applicant's mark from the Registrant's mark.

D. The Trade Channels Of Applicant And Registrant Are Dissimilar

The Examiner correctly indicates in the Final Office Action that likelihood of confusion is determined on the basis of the goods as they are identified in the application and registration. The Examiner emphasized in the Final Office Action that the limitation of the goods to the manufacture of electronic components was only limited to Class 1 in the Response to Office Action. Applicant has therefore amended the identification of goods in the remaining classes to specifically indicate that the goods are used for "manufacturing electronic components" or indicates the end use goods, "integrated circuit chips." The channels of trade are now clearly delineated and defined. The cited registration has no relationship to the Applicant's channel of trade. Because the channels of trade for the goods offered by Applicant and Registrant are different, there is no likelihood of confusion.

Applicant's goods are used in the semiconductor chip bonding field. The goods are highly specialized chemicals, metals and materials that are used for a sophisticated and highly specialized purpose. Registrant provides electrical resistance welders which are used in a highly technical and specialized field as well. Consumers shop for these goods in different locations and

for vastly different purposes. The differences among the goods make the channels of distribution and advertising distinct, thereby avoiding any likelihood of confusion.

E. The Consumers To Whom Sales Are Made Are Sophisticated And Purchase The Products With Considerable Care And Thought

As previously discussed, the cost associated with Applicant's and Registrant's goods is substantial. These products are purchased by educated professionals for a highly specialized purpose. It is inconceivable that these goods will be purchased on impulse. Although these purchasers are not immune to source confusion it is highly unlikely that these purchasers will be confused as to the source of the goods. It is well settled that confusion is less likely where the goods "are relatively expensive items purchased with a certain amount of care and thought, rather than inexpensive items purchased on impulse." Information Res. Inc. v. X*Press Info. Serv., 6 U.S.P.Q.2d 1034, 1039 (T.T.A.B. 1988).

Given the dissimilarity in the marks, the differences in the nature of the goods, the clearly defined trade channels, the different target group of potential consumers and the sophistication of those to whom sales are made, it is clear that there is no likelihood of confusion. When these elements are taken together, it is evident that Applicant's mark is not confusingly similar to the cited mark and Applicant's mark is registrable.

CONCLUSION


Applicant has addressed all outstanding issues raised by the Examining Attorney. Applicant respectfully requests that the application be approved for publication and earnestly solicits the Examining Attorney to take such action.

Applicant is concurrently filing the Notice of Appeal while the Examining Attorney considers the Request for Reconsideration filing.

Respectfully submitted,

Date: October 29, 2008

By:



Scott D. Woldow
Smith, Gambrell & Russell, LLP
1130 Connecticut Avenue, NW
Suite 800
Washington, DC 20036
Tel: (202) 263-4300
Fax: (202) 263-4329
Email: sdwoldow@sgrlaw.com

SDW
#319208



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

[Trademarks](#) > Trademark Acceptable Identification of Goods & Services

Trademark ID Manual



Refine Search: GERMAN

[Submit Query](#)

Documents: 1 - 1 of 1

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	006	German silver	A	01 May 05	G	N	

Refined Search: GERMAN

[Submit Query](#)

[Return to Search](#)

[HOME](#) [SITE INDEX](#) [SEARCH](#) [eBUSINESS](#) [HELP](#) [PRIVACY POLICY](#)





United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

[Trademarks](#) > Trademark Acceptable Identification of Goods & Services

Trademark ID Manual



Refine Search: SOLDER AND SILVER

[Submit Query](#)

Documents: 1 - 1 of 1

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	006	Silver solder	A	02 Apr 91	G	N	

Refined Search: SOLDER AND SILVER

[Submit Query](#)

Return to Search

[HOME](#) [SITE INDEX](#) [SEARCH](#) [eBUSINESS](#) [HELP](#) [PRIVACY POLICY](#)



File

Edit

View

Favorites

Tools

Help

Back

Forward

Home

Search

Star

Print

Stop

Reload

W

Close

Address

http://www.wipo.int/classifications/nivlo/nice/index.htm#

Go

Links

WIPCO

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; pipes and tubes

INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

under the Nice Agreement

Ninth Edition

- Search
- Preface
- Nice Agreement
- Madrid Agreement
- Protocol Relating to the Madrid Agreement
- Guidance for the User
- General Remarks
- Class Headings
- List of Classes with Explanatory Notes

Classes

A-Z

Goods

1 | 2 | 3 | 4 | 5

6 | 7 | 8 | 9 | 10

11 | 12 | 13 | 14 | 15

16 | 17 | 18 | 19 | 20

21 | 22 | 23 | 24 | 25

26 | 27 | 28 | 29 | 30

31 | 32 | 33 | 34

Services

35 | 36 | 37 | 38 | 39

40 | 41 | 42 | 43 | 44

45

Serial No. (E)	Indication of Goods or Services	Basic No.	Serial No. (F)
G0114	Aluminium	080147	G0177
G0129	Alloys of metal	060224	P0924
G0189	Aluminium (beryllium)	060043	B0320
G0217	Gold solder	080417	S0426
G0258	Gratings of metal	080152	G0337
G0282	Gravestone slabs of metal	080385	F0487
G0284	Gravestones of metal	060385	F0487
G0274	Grease nipples	060151	R0005
G0283	Greenhouse frames of metal	060316	C0561
G0284	Greenhouses of metal, transportable	060236	S0246
G0292	Grilles of metal	060152	G0337
G0308	Guard rails of metal	080095	C1212
G0355	Gutter pipes of metal	060356	D0115
G0357	Gutters of metal	060332	C0694
H0007	Hamium (cellium)	060067	C0376
H0063	Handcuffs	060181	M0266
H0070	Handles (Ferrules of metal for —)	060172	M0082
H0078	Handling pallets of metal	060175	P0036
H0089	Hardware * of metal, small	060227	Q0019

1 2 3 4 5 6 7 8 9 10 11

205 - 254 / 545

Search

Please enter query!

germanium

Search

Class	No of Hits	Hits
6	1	G0114

Done

Internet